THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOSEPH DEL GIORNO

Appeal No. 96-3157
Application 08/088,136[1]

ON BRIEF

Before HAIRSTON, McQUADE and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 6, 8 to 12 and 19 to 21.[2] Claims 3

[1] Application for patent filed July 7, 1993.

[2] Claim 19 was amended subsequent to the final rejection.

to 5, 7 and 13 to 18 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method of making individualized restaurant menus. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears on pages 1-2 of the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Madsen et al. (Madsen) 4,954,954 Sept. 4, 1990

Claims 1, 2, 6, 8 to 12 and 19 to 21 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1, 2, 6, 8 to 12 and 19 to 21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 20 and 21 stand rejected under 35 U.S.C. § 112,

fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claims 1, 2, 6, 8 to 12 and 19 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Madsen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 24, mailed January 29, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 22, filed December 18, 1995) and reply brief (Paper No. 25, filed March 29, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the

determinations which follow.

Initially we note that the entry of the appellant's amendment after final relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure

(MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by the appellant on pages 5 and 21-22 of the brief.

The non-statutory subject matter issue

We will not sustain the examiner's rejection of claims 1, 2, 6, 8 to 12 and 19 to 21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Section 101 of title 35, United States Code, provides:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Supreme Court has held that Congress chose the expansive language of 35 U.S.C. § 101 so as to include "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 308-09 (1980).

This perspective has been embraced by the Federal Circuit:

> The plain and unambiguous meaning of 101 is that any new and useful process, machine, manufacture, or composition

> of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in ' 102, 103, and 112. The use of the expansive term "any" in 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in 101 and the other parts of Title 35. . . . Thus, it is improper to read into 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations. [In re Alappat, 33 F.3d 1526, 1542, 31 USPQ2d 1545, 1556 (Fed. Cir. 1994) (in banc)]

As cast, 35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things" while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. § 100(b) ("The term 'process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.").

The Supreme Court has identified three categories of subject matter that are unpatentable, namely "laws of nature, natural phenomena, and abstract ideas." Diamond v. Diehr, 450

U.S. 175, 185 (1981). Ideas are not abstract if they are reduced to a practical application. State St. Bank & Trust v. Signature Fin. Group, Appeal No. 96-11327 at 10 (Fed. Cir. 1998).

In this case, the claims under appeal are clearly drawn to a process and thus constitute statutory subject matter under
35 U.S.C. § 101. In addition, we note that, contrary to the opinion of the examiner, the claims under appeal constitute a practical application of making an individualized restaurant menu for a customer desirous of avoiding ingestion of selected ingredients. Lastly, we note that there is no business method exception to 35 U.S.C. § 101. See State St. Bank & Trust v. Signature Fin. Group, supra, at 14-18.

For the reasons set forth above, the decision of the examiner to reject claims 1, 2, 6, 8 to 12 and 19 to 21 under 35 U.S.C. § 101 is reversed.

The indefiniteness issue

We will not sustain the examiner's rejection of claims 1,

2, 6, 8 to 12 and 19 to 21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

Furthermore, appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, it is clear to us that we cannot sustain the examiner's bases for this rejection (answer, pp. 8-9). In that regard, we regard the appellant's use of the phrase "perceptible to the customer" to define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. As to the examiner's question as to how presenting a menu to the customer (presumably the menu prepared by the claimed method) would safeguard the customer against ingestion of selected ingredients, we refer the examiner to the appellant's specification. In this regard, we note that the claims under appeal use the term safeguard, not the term prevent.

For the reasons set forth above, the decision of the examiner to reject claims 1, 2, 6, 8 to 12 and 19 to 21 under 35 U.S.C. § 112, second paragraph, is reversed.

The improper dependent claim issue

We will not sustain the examiner's rejection of claims 20 and 21 under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The fourth paragraph of section 112 of title 35, United States Code, provides:

> Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

The examiner determined (answer, p. 10) that dependent claims 20 and 21 were directed to preparing and delivering the meal to the customer and fail to define any further method steps for making an individual restaurant menu.

We agree with the appellant that claims 20 and 21 are proper dependent claims under the fourth paragraph of 35 U.S.C. § 112. We consider a claim that incorporates by reference all of the subject matter of another claim, that is, the claim is not broader in any respect, to be in compliance with the fourth paragraph of 35 U.S.C. § 112. See Ex parte Porter, 25 USPQ2d 1144 (Bd. Pat. App. & Int. 1992) and Ex parte Moelands, 3 USPQ2d 1474 ((Bd. Pat. App. & Int. 1987). Thus, there is nothing per se wrong with adding processing steps as in claim 20 or defining the output device as a

printer as claim 21[3]. Accordingly, dependent claims 20 and 21 which recite further limitations of the subject matter claimed in their respective independent claims are in compliance with the fourth paragraph of 35 U.S.C. § 112.

[3] We note that claim 21 inadvertently sets forth "Apparatus according to Claim 1" instead of "Method according to Claim 1." The appellant should amend claim 21 in due course.

For the reasons set forth above, the decision of the examiner to reject claims 20 and 21 under 35 U.S.C. § 112, fourth paragraph, is reversed.

The obviousness issue

We will not sustain the examiner's rejection of claims 1, 2, 6, 8 to 12 and 19 to 21 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual

to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on
§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Madsen discloses an apparatus for generating a balanced calorically limited menu. Madsen's invention relates to a method and apparatus for preparing a series of daily menus that include foods having preselected characteristics. The menus are prepared from a list containing numerous food items, the caloric content of each item, which food group each item

resides, and the applicability of each item for a particular meal. The daily menus are created from the items in the list in a manner such that each meal in each menu only includes items which are applicable to that meal, each meal has items from each of a preselected number of food groups, and each meal has a predetermined caloric content. After the menus are formed, selected items in the menus can be replaced, with each replacement item being applicable for the particular meal, being in the same food group, and having the same caloric content as the item that is replaced. The apparatus is an electronic digital computer which is programmed to automatically generate the menus for a particular gender and desired weight loss of the user, and then provide replacement items for particular items in the menu which satisfy the foregoing characteristics at the request of the user.

The examiner determined (answer, p. 11) that

> it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Madsen et al's method by inquiring the customer and selecting certain desired recipes not containing the avoided ingredients instead of selecting certain desired food items as in Madsen et al since selecting certain desired food items the user is avoiding certain undesired or

> unwanted food items and is effectively avoiding certain ingredients contained therein.

We agree with the appellant (brief, pp. 18-21) that Madsen does not suggest the claimed invention. In that regard, it is our view that the examiner's determination of obviousness set forth above is a classic case of impermissible hindsight since there is no factual evidence in the rejection as to why one would have made the proposed modifications to Madsen. In addition, we note that Madsen contains no suggestion of loading the names of all ingredients used by the restaurant into a database in a computer or inquiring of the customer which ingredients the customer wishes to avoid.

For the reasons set forth above, the decision of the examiner to reject claims 1, 2, 6, 8 to 12 and 19 to 21 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 6, 8 to 12 and 19 to 21 under 35 U.S.C. §§ 101, 103 and 112, second paragraph, is reversed; and the decision of the examiner to reject claims 20 and 21 under 35 U.S.C. §

112, fourth paragraph, is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
JOHN P. McQUADE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
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APPEAL NO. 96-3157 - JUDGE NASE

APPLICATION NO. 08/088,136

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APJ McQUADE

APJ HAIRSTON

DECISION: **REVERSED**

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DRAFT TYPED: 01 Sep 98

FINAL TYPED: